



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Yoshio AKIYAMA et al.

Group Art Unit: 1794

Application No.: 10/521,588

Examiner: M. JACOBSON

Filed: September 6, 2005

Docket No.: 122473

For: BLOW MOLDED ARTICLE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal and Petition for Extension of Time. Review of the May 29, 2008 Final Rejection is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believes that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Scott M. Schulte
Registration No. 44,325

JAO:KXH/amt

Date: September 26, 2008

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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REMARKS

Claims 1-3 and 5-12 are pending.

I. 35 U.S.C. §112, Second Paragraph

The May 29, 2008 Final Rejection (hereinafter "Office Action") rejects claim 12 under 35 U.S.C. §112, second paragraph, asserting that the term "low compatibility" is indefinite. Appellants traversed in the August 20, 2008 Request for Reconsideration (hereinafter "Request for Reconsideration") by arguing that, based on the disclosure of Appellants' specification, one of ordinary skill in the art would understand the meaning of the term "low" as recited in claim 12, and thus the term is not indefinite. That is, paragraph [0070] of the specification, for example, states that the resin material has a low compatibility with the outer layer 1a "thereby allowing to provide a laminated peelable container." Therefore, based on Applicants' disclosure, those skilled in the art, who have sufficient knowledge in the materials used to produce the blow molded article, would appreciate the level of the compatibility that is sufficiently low to make the contacting layers peelable from each other.

The Advisory Action failed to address this rejection. Withdrawal of the rejection is respectfully requested.

II. 35 U.S.C. §§102(b), 103(a)

The Office Action rejects claims 1-3 and 5 under 35 U.S.C. §102(b) over U.S. Patent No. 3,663,522 to Butcher; and rejects claims 6-12 under 35 U.S.C. §103(a) over Butcher in view of U.S. Patent 6,546,133 to Schmidt et al. (hereinafter "Schmidt"). These rejections are respectfully traversed.

Appellants respectfully submit that the Office Action made a clear error in law by improperly establishing inherency arguments based solely on the Examiner's opinion, and not based on the teaching of the applied references as set forth by the MPEP and the current case law.

With respect to the rejection of independent claim 1, the Office Action asserts that Butcher inherently discloses the equation $\pi D_p/n$, as recited in claim 1.

MPEP §2112 states that the Patent Office must provide rationale or evidence tending to show inherency. Citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQd 1949, 150-51 (Fed. Cir 1990), MPEP §2112 also states, "[i]nherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient" (emphasis added). Additionally, citing *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), MPEP §2112 states, "[i]n relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teaching of the applied prior art" (emphasis in original). Applicant respectfully submits that the Patent Office has not met its burden to show the inherency.

To show the inherency, the Office Action asserts that "[h]alf of the circumference pushed in to form half of the pinch off line" and "[s]ince the circumference of the parison was pinched off from two directions, the new maximum diameter of the parison produced would have a value of half of the circumference of the parison." Then, the Office Action conclusively states, without intermediate explanations, "[f]or n number of pinch off lines, the diameter of the inched off parison would have a circumference equal to $1/n C_p$ which would therefore translate into $D_{new} = 1/n \pi D_p$ " (where D_{new} is a diameter of a circumference of pinch-off lines, n is a number of the pinch-off lines, and D_p is a diameter of the parison).

First, Bucher does not teach or suggest that the diameter of the pinched off parison is controlled based on the number of pinch-off lines. The Examiner's use of two pinch-off lines in the example given is merely an arbitrary number not given by Butcher. In addition, the Office Action's alleged equation is a product based on the hindsight reasoning. That is, the Office Action clearly states that the circumference of the pinch-off lines is pushed to form

half of the pinch off line. Then, the Office Action asserts that the circumference of the pinch-off lines D_{new} is a half of the original diameter of the parison. The Office Action is clearly relying on a circumstance set up by itself, not from the teaching of Butcher, to establish the inherency argument. This is not the standard for establishing a proper inherency argument.

In addition, the Office Action provides an equation $C_{new} = \pi D_{new}$ (where C_{new} is a circumference of pinch-off lines), which is then allegedly translated into $D_{new} = 1/2 \pi D_p$. However, this number "1/2" in the translated equation comes from forming the circumference of the pinch-off lines by forming a half of the original circumference of the parison as discussed above. Therefore, the number "2" of "1/2" does not represent the number of pinch-off lines but merely represents the number of divisions of the diameter length of the pinch-off lines.

Furthermore, the Office Action does not reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teaching of the applied prior art. That is, the Office Action improperly replaces the number "2" in the alleged equation with an arbitrary number "n," and asserts that the equation is applicable in any number of the pinch-off lines. However, as discussed above, the number "2" in the alleged equation does not represent the number of pinch-off lines. Therefore, replacing the number with "n," which the Office Action alleges as the number of the pinch-off lines, is improper.

Moreover, even if the number "2" represents the number of pinch-off lines, Butcher does not teach or suggest controlling the diameter of the circumference of the pinch-off lines based on the number of the pinch-off lines. The Office Action assumes, without providing sufficient evidence, that the diameter is reduced as the number of pinch-off lines increase and has not shown, based on the teaching of Butcher, that the diameter of the circumference necessarily becomes smaller as the number of pinch-off lines increases. It is improper to rely on the assumption to establish the inherency argument.

Further, the Advisory Action asserts that Appellants have not shown evidence to show that the applied reference did not teach or suggest the equation recited in claim 1, and have not shown evidence that the Office Action's alleged equation was mathematically wrong.

MPEP §2112(V) states that "once a reference teaching product appearing to be substantially identical is made the basis of a rejection, and the Examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference."

As discussed above, the Patent Office has not properly shown inherency. Therefore, Applicant is not required to show an unobvious difference. In addition, Appellants respectfully submit that the above discussion of the problems of the Office Action's establishment of the inherency arguments and alleged equation, supports the clear evidence to show that the applied reference does not teach or suggest the equation recited in claim 1, and has shown evidence that the Office Action's alleged equation was mathematically wrong.

At least for the foregoing reasons, the Office Action's inherency argument is improper, and therefore, the rejection of claim 1 is improper.

Schmidt does not overcome the deficiencies of Butcher with respect to claim 1. Therefore, claims 2, 3 and 5-12 are allowable at least for their dependence on claim 1, as well as for the additional features they recite.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-3 and 5 under 35 U.S.C. §102(b), and claims 6-12 under 35 U.S.C. §103(a) over the applied references are respectfully requested.

In view of the foregoing, Appellants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-3 and 5-12 are earnestly solicited.